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Haynes and Boone, LLP IP Section 2323 Victory Avenue SUITE 700 Dallas, TX 75219			EXAMINER BENGZON, GREG C	
			ART UNIT 2444	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,010

Applicant(s)

CHANG, WILLIAM I.

Examiner

GREG BENZON

Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This application has been examined. Claims 1-45 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/02/2009 has been entered.

Priority

This application claims benefits of priority from Provisional Application 60/458287 filed March 31, 2003.

The effective date of the claims described in this application is March 31, 2003.

Information Disclosure Statement

The Applicant is respectfully reminded that each individual associated with the

filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in 37 CFR 1.56.

There were no information disclosure statements filed with this application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-45 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-45 are directed entirely towards a database and a directory, said components forming data structures and non-functional descriptive material. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.

The Examiner notes that the Applicant Specifications Page 1 indicate that the invention is related to application computer programs. The Examiner does not detect

an embodiment wherein the search engine is embodied as a computer program in a hardware device.

With respect to the *transaction tracking service*, *search engine* and other services and tools, the said *transaction tracking service* and *search engine* appear to be embodied as computer programs. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8,10,13 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438).

Enyart disclosed a fee-based messaging system wherein the customer is a sender of information, and the client is a recipient of this customer information.

Enyart disclosed (re. Claim 1) a system comprising: a subscriber profile database including electronic addresses (Enyart-Paragraph 21, *'database includes a registry of possible message recipients'*) and biographical and affinity information of subscribers to the system (Enyart-Paragraph 1006, *'opt in to receive paid email messages from vendors'*) ; and a electronic address directory for retrieving from the subscriber profile database electronic addresses of selected subscribers. (Enyart-Paragraph 66, *'select list of recipients'*)

Enyart disclosed a form of permission-fee based email system because the client (recipient) is accepting payment from the sender in exchange for ensuring that the sender's message is acted upon by the client (recipient). The Examiner notes that in permission-based email exchanges a receiver is allowed to opt-in to receive messages only from specified sources (sender). Furthermore Enyart Paragraph 66 disclosed a need for a sender (advertiser) to select a list of recipients. Enyart would have been motivated to search for disclosures regarding means for said sender to specify a search

criterion for selecting users (intended recipients) that have granted permission to receive from said sender. By following the permission-based rules for selecting recipients and sending offers, Enyart avoids having the sender implementing mass mailings (Enyart-Paragraph 65) and the sender avoids being marked as a SPAM sender (Enyart-Paragraph 1197). The Examiner further notes that Enyart penalizes recipients who do not act on the advertisers' messages (Enyart-Paragraph 63). Thus in implementing the search criterion for selecting users (intended recipients) Enyart also avoids penalizing recipients and avoids irritating those users who have no interest in the sender's offer.

While Enyart substantially disclosed the invention, Enyart did not explicitly disclose (re. Claim 1) a transaction tracking service which tracks each subscriber's registration messages.

While Enyart substantially disclosed the invention, Enyart did not explicitly disclose (re. Claim 1) selecting subscribers based on a search criterion selecting a specified biographical or affinity profile.

Coleman disclosed (re. Claim 1) a transaction tracking service which tracks each subscriber's registration messages. (Coleman-Figure 8, Paragraph 97-100, Px 103, 'the profiles of only those registered users who meet certain criteria will be presented to the advertisers')

Coleman disclosed a search engine for retrieving profile information, including electronic addresses of selected subscribers. (Coleman-Paragraph 81, 'searching if a registered user having specific information')

Furthermore Coleman disclosed (re. Claim 1) selecting subscribers based on a search criterion selecting a specified biographical or affinity profile. (Coleman-Paragraph 20-21, Paragraph 58, 'advertisements may be presented to only certain potential purchasers who meet requirements set by the advertiser')

Enyart and Coleman are analogous art because they present concepts and practices regarding email systems implementing permission-based direct email marketing. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Coleman into Enyart. The motivation for said combination would have been to enable aggregating a pool of purchasers for linking to sellers. (Coleman-Paragraph 9)

Enyart-Coleman disclosed (re. Claim 2) an electronic message forwarding service allowing sending electronic messages to the electronic addresses retrieved. (Enyart-Paragraph 83, 'email provider')

The motivation to combine as described in Claim 1 applies to Claim 2.

Enyart-Coleman disclosed (re. Claim 3) wherein the electronic addresses are electronic mail addresses. (Enyart-Paragraph 1006, *'opt in to receive paid email messages from vendors'*)

The motivation to combine as described in Claim 1 applies to Claim 3.

Enyart-Coleman disclosed (re. Claim 4) wherein the electronic mail forwarding service associates a sender's fee on each electronic message sent to a subscriber. (Enyart-Paragraph 67, *'advertiser preferably pays an appropriate fee to a service provider in order to transmit the message to recipients on the list'*)

The motivation to combine as described in Claim 1 applies to Claim 4.

Enyart-Coleman disclosed (re. Claim 5) wherein the subscriber classifies senders of electronic messages into a plurality of classes, and specifies a fee schedule for electronic messages according to the classes. (Enyart-Paragraph 74-*'a client will establish a set of tiers into which prospective senders are classified'*)

The motivation to combine as described in Claim 1 applies to Claim 5.

Enyart-Coleman disclosed (re. Claim 6) wherein the system provides tools for reclassifying a sender in a first class of senders to a second class of senders within the

subscriber's classification. (Enyart-Paragraph 79,' *clients can readily modify this arrangement so as to charge whatever they wish for any category of customer*)

The motivation to combine as described in Claim 1 applies to Claim 6.

Enyart-Coleman disclosed (re. Claim 7) wherein the system provides tools for waiving a part of a sender's fee received for an electronic message received. (Enyart-Paragraph 75,Paragraph 81)

The motivation to combine as described in Claim 1 applies to Claim 7.

Enyart-Coleman disclosed (re. Claim 8) wherein each electronic message is assigned a life time, and wherein upon expiration of the life time, the sender's fee is returned. (Enyart-Paragraph 599,' *If the Client does not Reply to the sender within the Guaranteed Reply Refund Period of 1 month, then 900Email will refund to the Customer*', Paragraph 701-703)

The motivation to combine as described in Claim 1 applies to Claim 8.

Enyart-Coleman disclosed (re. Claim 10) wherein the electronic addresses are verified from time to time to ensure integrity. (Enyart-Paragraph 1561,' *verify that the*

intended recipients have valid 900Email system accounts')

The motivation to combine as described in Claim 1 applies to Claim 10.

Enyart-Coleman disclosed (re. Claim 13) wherein the system further comprises tools for building an online community. (Enyart-Paragraph 55, Paragraph 1005, '*public directory for listing entities that want business referrals*')

The motivation to combine as described in Claim 1 applies to Claim 13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Law (US Publication 20060229934).

The Examiner notes that Enyart (Enyart-Paragraph 42, Paragraph 645) disclosed email forwarding.

While Enyart-Coleman substantially disclosed the claimed invention Enyart-Coleman did not disclose (re. Claim 11) wherein a subscriber specifies an out-of-service electronic address and a current electronic address to which electronic messages addressed to the out-of-service address are forwarded.

Furthermore Law disclosed (re. Claim 11) wherein a subscriber specifies an out-of-service electronic address and a current electronic address to which electronic messages addressed to the out-of-service address are forwarded. (Law-Paragraph 23, *temporary reroute messages instruction may be utilized by the recipient 180 when the recipient 180 wished to have messages sent to an alternate address*)

Enyart, Coleman and Law are analogous art because they present concepts and practices regarding email systems implementing permission-based direct email marketing. (Law-Paragraph 30) At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Law into Enyart-Coleman. The motivation for said combination would have been (Law-Paragraph 9) to enable a more efficient and effective process for senders to provide recipients with messages.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Law (US Publication 20060229934) further in view of Kubic (US Patent 6959324) .

While Enyart-Coleman-Law substantially disclosed the claimed invention Enyart-Coleman-Law did not disclose (re. Claim 12) electronic message forwarding service allowing sending electronic messages to the electronic addresses retrieved, wherein the electronic message forwarding service verifying the out-of-service address by sending probing messages addressed to the out-of-service address from time to time to elicit a unsuccessful delivery reply.

The Examiner notes that at the time of the invention testing for inactive email addresses was well-known in the networking art. It was well-known to have email providers send an unsuccessful delivery reply in order to discourage repetitive mailing to said email address that leads to performance degradation.

Furthermore Kubik disclosed (re. Claim 12) electronic message forwarding service allowing sending electronic messages to the electronic addresses retrieved, wherein the electronic message forwarding service verifying the out-of-service address by sending probing messages (Kubik-Column 6 Lines 50-65,' *e-mail tester program 512, which tests e-mail addresses to determine whether addresses are valid or invalid.*') addressed to the out-of-service address from time to time to elicit an unsuccessful delivery reply. (Kubik-Column 1 Lines 35-40)

Enyart,Coleman, Law, and Kubik are analogous art because they present concepts and practices regarding email systems. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Kubik into Enyart-Coleman-Law. The motivation for said combination would have been (Law-Paragraph 9) to enable a more efficient and effective process for senders to provide recipients with messages.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-21,24-26,31-33, 37-45 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505)) in view of Coleman (US Publication 2007/0083438) in view of Goodwin (US Publication 2003/0163485) .

The Examiner notes that Enyart disclosed a public directory for contacting users. (Enyart-Paragraph 1005-1006)

While Enyart-Coleman substantially disclosed the claimed invention Enyart-Coleman did not disclose (re. Claim 14) wherein the database further comprises information of interest to the subscribers.

Goodwin disclosed (re. Claim 14) wherein the database further comprises information of interest to the subscribers. (Goodwin-Paragraph 55,Paragraph 72)

Enyart,Coleman and Goodwin are analogous art because they present concepts and practices regarding email systems for users with the same affinity. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Goodwin into Enyart-Coleman. The motivation for said combination would have been to provide relevant information about the user's field of interest and also to indicate a user's affinity to the general public. (Goodwin-Paragraph 4, Paragraph 16, Paragraph 74)

Enyart-Coleman-Goodwin disclosed (re. Claim 15) wherein the information of interest is classified according to a plurality of taxonomy trees, each taxonomy tree being defined according to a value of a subscriber-provided property. (Goodwin-

Paragraph 72, '*weighted sum*', Paragraph 114)

The motivation to combine as described in Claim 14 applies to Claim 15.

Enyart-Coleman-Goodwin disclosed (re. Claim 16) wherein the information of interest comprises results of searches of information resources accessible on the internet. (Goodwin-Paragraph 58)

The motivation to combine as described in Claim 14 applies to Claim 16.

Enyart-Coleman-Goodwin disclosed (re. Claim 17) wherein the information resources comprises web pages of the world wide web. (Goodwin-Paragraph 64)

The motivation to combine as described in Claim 14 applies to Claim 17.

Enyart-Coleman-Goodwin disclosed (re. Claim 18) wherein the information resources comprises affinity groups. (Goodwin-Paragraph 66, Paragraph 107)

The motivation to combine as described in Claim 14 applies to Claim 18.

Enyart-Coleman-Goodwin disclosed (re. Claim 19) wherein queries regarding the information of interest is retrieved, upon receipt of a query, by searching the plurality of

taxonomy trees. (Goodwin-Paragraph 107, Paragraph 122)

The motivation to combine as described in Claim 14 applies to Claim 19.

Enyart-Coleman-Goodwin disclosed (re. Claim 20) wherein the information of interest is retrieved, upon receipt of a query in an electronic message, by forwarding the electronic message to an electronic address specified by a subscriber who advertises expertise in a subject matter of the query. (Goodwin-Paragraph 138-139)

The motivation to combine as described in Claim 14 applies to Claim 20.

Enyart-Coleman-Goodwin disclosed (re. Claim 21) wherein the information of interest includes celebrity personal information (Enyart-Paragraph 52) which is retrieved, upon receipt of a query in an electronic message, by forwarding the electronic message to an electronic address specified by a corresponding celebrity subscriber. (Goodwin-Paragraph 138-139)

The motivation to combine as described in Claim 14 applies to Claim 21.

Enyart-Coleman-Goodwin disclosed (re. Claim 24) wherein the transaction tracking service collects information regarding subject matters of the subscriber's registration messages. (Coleman-Figure 8, Paragraph 97-100)

The motivation to combine as described in Claim 14 applies to Claim 24.

Enyart-Coleman-Goodwin disclosed (re. Claim 25) wherein the collected information is integrated into the subscriber profile database. (Enyart-Paragraph 1128)

The motivation to combine as described in Claim 14 applies to Claim 25.

Enyart-Coleman-Goodwin disclosed (re. Claim 26) an electronic message forwarding service allowing sending electronic messages to the electronic addresses retrieved, wherein the electronic message forwarding service comprises an electronic message route-through service. (Enyart-Paragraph 42, Paragraph 645)

The motivation to combine as described in Claim 14 applies to Claim 26.

Enyart-Coleman-Goodwin disclosed (re. Claim 31) wherein the sender's fee levied on an electronic message for each subscriber is specified by the subscriber. (Enyart-Paragraph 74)

The motivation to combine as described in Claim 14 applies to Claim 31.

Enyart-Coleman-Goodwin disclosed (re. Claim 32,40) a subscriber search gateway (Goodwin-Paragraph 145,'portal') that enables a sender (1) to search the

electronic address directory (Goodwin-Paragraph 145, '*search input*') to retrieve electronic addresses based on a combination of two or more of keywords, biographical, affinity information, and the sender's fees and (2) to send messages through the electronic message forwarding service messages (Enyart-Paragraph 73) to a portion of the electronic addresses retrieved accompanied by the sender's fees.

The motivation to combine as described in Claim 14 applies to Claim 32,40.

Enyart-Coleman-Goodwin disclosed (re. Claim 33) an electronic message mailbox service for each subscriber that provides a ranking of electronic messages (Enyart-Paragraph 33, '*expedited service*') sent to the subscriber, and wherein the is allowed to provide a premium fee greater than the sender's fee specified by the subscriber to obtain a higher ranking than electronic messages providing the sender's fee specified by the subscriber. (Enyart-Paragraph 1354)

The motivation to combine as described in Claim 14 applies to Claim 33.

Enyart-Coleman-Goodwin disclosed (re. Claim 37) a content search gateway (Goodwin-Paragraph 145) which enables a subscriber to search for information in one or more information resources using a query, wherein the content search gateway processes both the query and the result of the search to update affinity information of the subscriber in the subscriber profile database. (Goodwin-Paragraph 150, '*maintain profile and affinities*')

The motivation to combine as described in Claim 14 applies to Claim 37.

Enyart-Coleman-Goodwin disclosed (re. Claim 38) wherein the content search gateway supports searching using a browser to access the world wide web. (Enyart-Paragraph 258-261)

The Examiner notes that at the time of the invention the use of web browsers were well-known in the networking art. It would have been obvious to combine what was well-known regarding browsers in order to provide an interactive interface for searching.

The motivation to combine as described in Claim 14 applies to Claim 38.

Enyart-Coleman-Goodwin disclosed (re. Claim 39) wherein the content search gateway supports searching using an email message. (Goodwin-Paragraph 128-129)

The motivation to combine as described in Claim 14 applies to Claim 39.

Enyart-Coleman-Goodwin disclosed (re. Claim 41) wherein the content search gateway includes commercial information (Enyart-Paragraph 68, '*distributed advertising material*') with the result to the query that is retrieved based on both the query and the subscriber's affinity information in the subscriber profile database.

The motivation to combine as described in Claim 14 applies to Claim 41.

Enyart-Coleman-Goodwin disclosed (re. Claim 42) wherein the content search

gateway tracks the subscriber's response to the commercial information included in the result. (Enyart-Paragraph 68,' *quantify the amount of actual customer readership of the distributed advertising materials.*'))

The motivation to combine as described in Claim 14 applies to Claim 42.

Enyart-Coleman-Goodwin disclosed (re. Claim 43) wherein the content search gateway provides the subscriber a search digest. (Goodwin-Paragraph 130,'document summaries', Paragraph 134)

The motivation to combine as described in Claim 14 applies to Claim 43.

Enyart-Coleman-Goodwin disclosed (re. Claim 44) wherein the search digest summarizes the results of more than one query. (Goodwin- Paragraph 130,'document summaries',)

The motivation to combine as described in Claim 14 applies to Claim 44.

Enyart-Coleman-Goodwin disclosed (re. Claim 45) wherein the content search gateway enables a subscriber to select a plurality of search algorithms (Goodwin-Paragraph 124) from a group including algorithms of different levels of sophistication, targeted spidering (Goodwin-Paragraph 133) and content discovery, and forwarding the

query to a human expert or an online community. (Goodwin-Paragraph 134)

The motivation to combine as described in Claim 14 applies to Claim 45.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505)) in view of Coleman (US Publication 2007/0083438) in view of Goodwin (US Publication 2003/0163485) in view of Fratkina (US Publication 2005/0055321) .

The Examiner notes that Goodwin disclosed (Goodwin-Paragraph 118) determining the frequency of cluster terms.

While Enyart-Coleman-Goodwin substantially disclosed the invention, Enyart-Coleman-Goodwin did not disclose (re. Claim 22) wherein queries to retrieved the information of interest and responses to the queries are selectively included in a frequently asked questions database.

Furthermore Fratkina disclosed (re. Claim 22) wherein queries to retrieved the information of interest and responses to the queries are selectively included in a frequently asked questions database. (Fratkina-Paragraph 335,' report showing frequently asked questions')

At the time of the invention it would have been obvious to combine the teachings of Fratkina regarding FAQ databases into Enyart-Coleman-Goodwin. The motivation for said combination would have been to model the way an expert elicits information. (Fratkina-Paragraph 10)

Enyart-Coleman-Goodwin-Fratkina disclosed (re. Claim 23) wherein the frequently asked questions database is improved by subscribers provided feedback. (Fratkina-Paragraph 11, Paragraph 336)

The motivation to combine as described in Claim 22 applies to Claim 23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) in view of Goodwin (US Publication 2003/0163485) further in view of Karamchedu (US Publication 2004/0201625).

While Enyart-Coleman-Goodwin substantially disclosed the claimed invention Enyart-Goodwin did not disclose (re. Claim 34) wherein the electronic message mailbox service allows a subscriber to specify a daily maximum limit on the number of eMail messages that is received from unsolicited sources.

Karamchedu disclosed (re. Claim 34) wherein the electronic message mailbox service allows a subscriber to specify a daily maximum limit on the number of eMail messages that is received from unsolicited sources. (Karamchedu-Figure 3, Paragraph 22)

Enyart, Coleman, Goodwin, Karamchedu are analogous art because they present concepts and practices regarding email systems. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Karamchedu into

Enyart-Coleman-Goodwin. The motivation for said combination would have been to prevent loss in productivity due to undesired email. (Karamchedu-Paragraph 3)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) in view of Goodwin (US Publication 2003/0163485) further in view of Moskowitz (US Patent 7280982).

While Enyart-Coleman-Goodwin substantially disclosed the claimed invention Enyart-Coleman-Goodwin did not disclose (re. Claim 27) wherein the electronic route-through service retrieves electronic messages from a subscriber's public mailbox, processes the retrieved electronic messages by a subscriber-specified service, and forwards the processed electronic messages to the subscriber's private mailbox.

Furthermore Moskowitz disclosed (re. Claim 27) wherein the electronic route-through service retrieves electronic messages from a subscriber's public mailbox, processes the retrieved electronic messages by a subscriber-specified service, and forwards the processed electronic messages to the subscriber's private mailbox. (Moskowitz-Column 2 Lines 30-50)

Enyart, Coleman, Goodwin, and Moskowitz are analogous art because they present concepts and practices regarding email systems. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Moskowitz into Enyart-Coleman-Goodwin. The motivation for said combination would have been to protect the privacy of the user's personal mailbox. (Moskowitz-Column 2 Lines 35-40)

Enyart-Coleman-Goodwin-Moskowitz disclosed (re. Claim 28) wherein the subscriber-specified service comprises verification of identities of senders of the retrieved electronic messages. (Enyart-Paragraph 853)

The motivation to combine as described in Claim 27 applies to Claim 28.

Enyart-Coleman-Goodwin-Moskowitz disclosed (re. Claim 29) wherein the electronic route-through service periodically accesses a subscriber's mailbox to process electronic messages in the public mailbox by a subscriber-specified service. (Moskowitz-Column 2 Lines 30-50)

The motivation to combine as described in Claim 14 applies to Claim 29.

Enyart-Coleman-Goodwin-Moskowitz disclosed (re. Claim 30) wherein the subscriber-specified service comprises verification of identities of senders of the electronic messages in the subscriber's mailbox. (Enyart-Paragraph 853)

The motivation to combine as described in Claim 14 applies to Claim 30.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) in view of Moskowitz (US Patent 7280982).

While Enyart-Coleman substantially disclosed the claimed invention Enyart-Coleman did not disclose (re. Claim 35) wherein the electronic message forwarding service sends a sender of electronic message not accompanied by a sender's fee an invoice for the sender's fee, and defers forwarding the electronic message until the invoice is paid.

The Examiner notes that Enyart disclosed (Enyart-Paragraph 570) of notifying the sender for insufficient postage and holding email in the Post Office Dumpster (Enyart-Paragraph 572). Enyart also disclosed (Enyart-Paragraph 579) holding mail delivery until the recipient pays a fee to retrieve the email from the dumpster.

It would have been an obvious variation of Enyart to wait for the sender to pay the postage fee before forwarding the email to the recipient so that the recipient user is assured of payment before reading the advertisement.

Furthermore Moskowitz disclosed (re. Claim 35) wherein the electronic message forwarding service sends a sender of electronic message not accompanied by a sender's fee an invoice for the sender's fee, and defers forwarding the electronic message until the invoice is paid. (Moskowitz-Column 3 Lines 20-30)

Enyart, Coleman and Moskowitz are analogous art because they present concepts and practices regarding email systems. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Moskowitz into

Enyart-Coleman. The motivation for said combination would have been to allow for settlement/clearinghouse procedures to be implemented for large (sender) accounts.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Sweeney (US Publication 2005/0004837).

While Enyart-Coleman disclosed (Coleman-Paragraph 58) wherein advertisements may be presented to only certain potential purchasers (intended recipients) who meet requirements set by the advertiser, Enyart-Coleman did not disclose (re. Claim 9) allowing the subscriber to specify a number of electronic addresses according to the content of electronic messages to be received at each electronic address.

Sweeney disclosed (re. Claim 9) allowing the subscriber to specify a number of electronic addresses according to the content of electronic messages to be received at each electronic address. (Sweeney-Paragraph 96, *'the recipient user sends the offer to other people that might be interested in the content'*)

Enyart-Coleman and Sweeney are analogous art because they present concepts regarding email systems implementing permission-based direct email marketing. Thus at the time of the invention it would have been obvious to combine Sweeney into Enyart-Coleman. The motivation for said combination would have been (Sweeney-Paragraph 22) to enable a viral, self-propagating way to reach an entire community of interest, and only that community of interest.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505)) in view of Coleman (US Publication 2007/0083438) in view of Goodwin (US Publication 2003/0163485) further in view of Sweeney (US Publication 2005/0004837).

While Enyart-Coleman-Goodwin disclosed determining when an electronic message sent to one of the electronic addresses retrieved is unread after a specified time period, Enyart-Coleman-Goodwin did not disclose (re. Claim 36) wherein the subscriber search gateway further enables the sender to redirect said electronic message sent to another one of the electronic addresses retrieved.

Furthermore Sweeney disclosed (re. Claim 36) redirecting email advertising to a second selected recipient if the first recipient is not interested in the sender's email. (Sweeney-Paragraph 35-37, 'Compound affiliated e-mail marketing')

The Examiner notes that at the time of the invention the process of redirecting and forwarding emails was well-known in the networking art. Furthermore at the time of the invention where Enyart disclosed a list of potential business contacts, it would have been obvious to try each one of the potential contacts until one of the potential contacts agrees to the business offering, in order to provide a higher rate of success for the business offering.

Enyart-Coleman-Goodwin and Sweeney are analogous art because they present concepts regarding email systems implementing permission-based direct email marketing. Thus at the time of the invention it would have been obvious to combine Sweeney into Enyart-Coleman-Goodwin. The motivation for said combination would have been (Sweeney-Paragraph 22) to enable a viral, self-propagating way to reach an entire community of interest, and only that community of interest.

Thus Enyart-Coleman-Goodwin-Sweeney disclosed (re. Claim 36) wherein the subscriber search gateway further enables the sender to redirect when an electronic message sent to one of the electronic addresses retrieved is unread after a specified time period to another one of the electronic addresses retrieved.

The Examiner notes that at the time of the invention the process of redirecting and forwarding emails was well-known in the networking art. Furthermore at the time of the invention where Enyart disclosed a list of potential business contacts, it would have been obvious to try each one of the potential contacts until one of the potential contacts agrees to the business offering, in order to provide a higher rate of success for the business offering.

Response to Arguments

Applicant's arguments filed 03/02/2009 have been fully considered but they are not persuasive.

The Examiner maintains the USC 101 rejection in view of the lack statutory subject matter in the claims. The Examiner notes that the Applicant Specifications Page 1 indicate that the invention is related to application computer programs. The Examiner does not detect an embodiment wherein the search engine is embodied as a computer program in a hardware device.

The Applicant presents the following argument(s) *[in italics]*:

...As discussed in Applicant's Specification, at page 10, lines 14-22, tracking such messages allow the system to both avoid mistakenly rejecting messages and to learn the on-line shopping behavior the subscribers, which may be valuable to advertisers. In contrast, Coleman's Figure 8 and paragraphs 97-100 teaches tracking, rather than registration messages, potential purchasers who have specifically and expressly indicated a purchase interest in a good or service.

The Examiner respectfully disagrees with the Applicant.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., 'avoid mistakenly rejecting messages and to learn the on-line shopping behavior the subscribers') are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

The Examiner notes that each potential purchaser is required to register in order to be recognized as such. Furthermore Coleman disclosed a potential user signing up for a deal which is equivalent to a registration process. Since Coleman involves updating profiles with new information regarding the said deals, wherein the new information is captured during the sign-up process ('registration') then Coleman disclosed tracking responses to registration messages.

Furthermore Coleman disclosed a search engine for retrieving profile information including electronic addresses of selected subscribers. (Coleman-Paragraph 81, 'searching if a registered user having specific information')

Coleman Paragraph 108 disclosed wherein only profiles having certain criteria are provided to the advertisers.

Thus Enyart-Coleman fully disclosed *a subscriber profile database including electronic addresses and biographical and affinity information of subscribers to the system; a transaction tracking service which tracks each subscriber's registration messages; and one or more search engines which operate the transaction tracking service and an electronic address directory; wherein, in response to a query of the*

electronic address directory, the search engines retrieve from the subscriber profile database electronic addresses of selected subscribers based on a search criterion selecting a specified biographical or affinity profile.

Conclusion

The Examiner notes that at the time of the invention email systems implementing permission-based direct email marketing was well-known in the networking art. (See Lanzillo US 2002/0032602).

Furthermore the use of search criterion for selecting targeted recipients was also well-known in the networking art. Furthermore the use of databases and search/retrieval facilities were well-known in the networking art. (See Weitzman US Publication 2002/0099605)

The methods for matching potential buyers with targeted advertisements were well-known in the art. (See Coleman US Publication 20070083438).

The Examiner notes that at the time of the invention alternate address forwarding was well-known in the networking art. (See Fuisz US Patent 7188144)

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. B./
Examiner, Art Unit 2444

/William C. Vaughn, Jr./
Supervisory Patent Examiner, Art Unit 2444